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09/853,835	05/10/2001	William Ray Cooley	P0367	6454

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DIGIMARC CORPORATION  
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EXAMINER

HA, LEYNNA A

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/853,835

Applicant(s)

COOLEY ET AL.

Examiner

LEYNNA T. HA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/13/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-27 and 29-37 have been reexamined and are pending.

Claim 26 have been amended to include the limitations of claim

28. Claims 28 and 38 have been cancelled.

2. Claims 1-27 and 29-37 remains rejected.

3. This is a Non-Final rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipate by Venkatesan, et al. (US 6,801,999).**

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**As per claim 1:**

Venkatesan, et al. discloses a method of regulating access to a website by a user terminal via the Internet, the user terminal reading a document including an embedded digital watermark, said method comprising:

at the user terminal, extracting identifying data from the digital watermark, and providing the identifying data to a central computer;

**[col.25, lines 3-5 and 7-8]**

at the central computer:

identifying a pointer associated with the identifying data; **[col.15,**

**line 47-50]**

generating at least one component of response information; storing the response information; and **[col.15, line 51-58 and col.28, lines 17-24]**

providing the pointer and response information to the user terminal; **[col.24, line 64 – col.25, line 3]**

at the user terminal, communicating with the website **[col.14, line 25-33]** via the pointer **[col.13, lines 55-59]** and providing the response information to the website; **[col.30, line 11-17]**

at the website, communicating verification information to the central computer; and **[col.13, line 39]**

at the central computer, verifying authority **[col.14, lines 6-8 and col.23, line 9-12]** to access the website based at least in part on a comparison of the verification information and the stored response

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information. [col.29, lines 1-8]

**As per claim 2:** See col.13, line 30 and col.14, lines 34-35; discussing the identifying data comprises a document identifier.

**As per claim 3:** See col.14, lines 26-27 and 29, lines 11-13; discussing the pointer comprises at least one of a URL, IP address and web address.

**As per claim 4:** See col.27, lines 10-14; discussing at least one component comprises a random number.

**As per claim 5:** See col.25, lines 18-22; discussing generating at least a second component, the second component comprising a time stamp.

**As per claim 6:** See col.25, lines 18-22 and col.27, lines 10-14; discussing the response information comprises at least the random number and the time stamp.

**As per claim 7:** See col.14, lines 34-35 and col.25, lines 18-22 and col.27, lines 10-14; discussing the verification information comprises at least the random number, the time stamp and a valid identifier.

**As per claim 8:** See col.14, lines 6-8 and col.23, line 9-12; discussing said verifying authority comprises indexing the stored response information via the communicated random number and determining whether the stored document identifier matches the valid identifier and whether the verification information is received within a predetermined time period.

**As per claim 9:** See col.11, lines 33-46; discussing when the stored document identifier matches the valid identifier within the predetermined

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time period, said method further comprising authorizing user terminal access to the website.

**As per claim 10:** See col.17, lines 50-64; discussing when the stored document identifier does not match the valid identifier or the verification information is not received within the predetermined time period, said method further comprises signaling a lack of authority for the user terminal to access the website.

**As per claim 11:** See col.17, lines 50-64 and col.27, lines 11-16; discusses verifying authority comprises indexing the stored response information via the valid identifier and determining whether the stored random number matches the communicated random number, and whether the verification information is received within a predetermined time period.

**As per claim 12:** See col.14, line 15 and col.18, line 49; discusses encrypting at least one component of the of the response information.

**As per claim 13:** See col.17, lines 41-42 and 27, lines 10-13; discussing the document identifier is randomly generated.

**As per claim 14:**

Venkatesan teaches a method of authenticating permission to access a system comprising:

receiving a request to enter the system, the request including at least a verification key; [col.21, lines 55-56 col.27, lines 10-13]

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querying a data structure to determine whether the verification key is authorized; and **[col.22, lines 32-43]**

allowing access to the system based on the response to the query.

**[col.22, lines 55-60]**

**As per claim 15:** See col.13, lines 57-58 and col.29, lines 11-13; discussing a website.

**As per claim 16:** See col.13, lines 57-58 and col.29, lines 11-13; discussing receiving comprises a user terminal signaling the website.

**As per claim 17:** See col.14, lines 10-15 and col.27, lines 10-13; discussing verification key comprises a first random number, and the data structure comprises at least one data record including a second random number and a first identifier.

**As per claim 18:** See col.17, lines 32-64; discussing the verification key further comprises a first time stamp and the data record further includes a second time stamp.

**As per claim 19:** See col.23, lines 10-25 and col.25, lines 18-22 and col.27, lines 10-14; discussing indexes the data record via the first random number, the first and second random numbers being equal, determines whether the first identifier matches the second identifier, and whether the first time stamp is within a predetermined time range based on the second time stamp, and signals to the system whether the first identifier matches the second identifier and whether the first time stamp is within the predetermined time range.

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**As per claim 20:** See col.25, lines 7-8; discussing the first identifier comprises an identifier extracted from a digital watermark.

**As per claim 21:** See col.23, lines 10-25 and col.25, lines 18-22 and col.27, lines 10-14; discussing indexes the data record via the second identifier, the first identifier and second identifier being equal, determines whether the first random number matches the second random number, and signals to the system whether the first random number matches the second random number and whether the verification information is received within a predetermined time.

**As per claim 22:**

Venkatesan discloses a system for exchanging data comprising:

a central server comprising at least one database [col.18, lines 62-67] including response information and pointer information [col.13, lines 55-59 and col.24, line 64 – col.25, line 3], wherein when a user terminal communicates an extracted watermark identifier to said central server [col.25, lines 3-5 and 7-8], said central server identifies a corresponding URL with the extracted watermark identifier [col.15, lines 47-58 and 23, lines 46-51], and wherein said central server generates a number, and stores the number and extracted watermark identifier in the database as response information. [col.31, lines 58-65]

**As per claim 23:** See col.11, lines 39-45 and col.15, lines 51-52; discussing at least one database comprises a first database for storing pointers and a second database for storing response information.

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**As per claim 24:** See col.25, lines 20-22; discussing server further generates a time stamp and stores the time stamp with the response information.

**As per claim 25:** See col.13, line 35 and col.25, lines 20-22; discussing the number comprises at least one of a random number, a pseudo-random number, and a predetermined number.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 26-37 are rejected under 35 U.S.C. 102(e) as being anticipate by Moskowitz, et al. (US 5,822,432).**

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**As per claim 26:**

Moskowitz teaches a method of operating a computer server, the computer server to communicate with at least one user terminal, said method comprising:

receiving a document identifier from the user terminal; **[col.9,**

**lines 1-16 and 44-45]**

identifying a pointer associated with the document identifier **[col.6, lines 24-25]** wherein the pointer comprises at least one of a URL, IP address and web address; **[col.9, lines 29-32]**

generating at least one component of response information; **[col.9, lines 17-24]**

storing the response information; and **[col.5, lines 35-39 and col.6, lines 25-40]**

providing the pointer and response information to the user terminal. **[col.9, lines 33-38]**

**As per claim 27:** See col.3, lines 23-25; discussing the document identifier comprises an identifier embedded in the form of a digital watermark.

**As per claim 28:** **Cancelled**

**As per claim 29:** See col.6, lines 17-18; discussing the at least one component comprises a random number.

**As per claim 30:** See col.9, line 41; discussing the response information further comprises a time stamp.

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**As per claim 31:** See col.6, lines 17-18 and col.9, line 41; discussing the response information comprises at least a random number and a time stamp.

**As per claim 32:** See col.6, lines 17-20 and col.9, lines 40-51; discussing verifying data, wherein said verifying data comprises indexing the stored response information via a second random number, and determining whether the stored document identifier matches a valid identifier.

**As per claim 33:** See col.9, lines 17-21 and 40-51; discussing when the stored document identifier matches the valid identifier, said method further comprises authorizing user terminal access.

**As per claim 34:** See col.3, lines 43-58 and col.9, lines 25-26; discussing when the stored document identifier does not match a valid identifier, said method further comprises signaling a lack of authority for the user terminal.

**As per claim 35:** See col.6, lines 17-20 and col.9, lines 40-51; discussing verifying data comprises indexing the stored response information via a valid identifier and determining whether the stored random number matches a second random number.

**As per claim 36:** See col.6, line 16-20; discussing encrypting at least one component of the response information.

**As per claim 37:** See col.3, line 24-26; discussing the document identifier

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is randomly generated.

**As per claim 38:                      Cancelled**

***Response to Arguments***

***6.      Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive.***

The Examiner finds the claim language broad and interprets the claimed language the broadest reasonable limitation. Although, the Examiner points to a certain citation in Venkatesan in the last office action, the entire Venkatesan document should be taken as its entirety as reference for the rejection. So if the Examiner cited a certain column, it does not mean the rest of the Venkatesan document is unaccounted for.

Thus, Applicant's argument concerning the cited COL.5 and COL.11 is deficient in disclosing the "extracting identifying data from the digital watermark", does not mean these cited columns fails to teach this limitation but that the cited columns poorly represents the limitation according to the Applicant. The previously cited columns does not limit the prior art and only considered for the rejection, but there are other parts of the prior art that also teaches this limitation and be taken into

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consideration. For instance, Venkatesan does teach extracting the identifying data from the watermark [col.25, lines 3-5 and 7-8] and pointing to the location [col.13, lines 55-59 and col.24, line 64 – col.25, line 3] of the response data to the verifying authority to compare. [col.29, lines 1-8 and col.30, line 11-17]. Claim 1 includes the limitation of a pointer where “communicating with the website via the pointer” where the Examiner broadly interprets this limitation as in communicating with the website the pointer shows the location of the corresponding identifying data or response information in order to use for verification purposes.

Claim 14 broadly claims authenticating permission to access a system where the limitations fails to include any watermarking or a pointer to a website as argued by Applicant.

Claim 22 is a broader version to claim 1 and merely claims pointer information where the Examiner can broadly take this as data relating to pointing to a location. This does not claim to a specific location or a specified address/URL. Venkatesan teaches extracting the identifying data from the watermark [col.25, lines 3-5 and 7-8] and pointing to the location [col.13, lines 55-59 and col.24, line 64 – col.25, line 3] of the response data to the verifying authority to compare. [col.29, lines 1-8 and col.30, line 11-17].

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEYNNA T. HA whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LHa

  
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